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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,819	02/22/2002	Edward O. Clapper	ITL.0694US (P13225)	3076
7590 10/05/2005			EXAMINER	
Timothy N. Trop TROP, PRUNER & HU, P.C. STE. 100 8554 KATY FWY HOUSTON, TX 77024-1841			ANWAH, OLISA	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,819

Applicant(s)

CLAPPER, EDWARD O.

Examiner

Olisa Anwah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 15-22, 24 and 31-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14, 23, 25-30 and 38-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 9-12, 14, 23, 25-28 and 39-47 are rejected under 35 U.S.C. § 102(e) as being anticipated by Stogel, U.S. Patent Application Publication No. 2002/0159574 (hereinafter Stogel).

Regarding claim 9, Stogel teaches a system comprising:

a personal-use device that is standalone, portable, and separate from a telephone (135, 133) and another personal-use device (141, 145), the standalone device connectable to at least one of a telephone line (187) or the other personal-use device (141, 145), the standalone, portable device having:

a processor (101);

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a storage (115) coupled to said processor (101) to store a first database with a plurality of records, each containing a telephone number, a name and other information (paragraph 0011); and

an application stored in said storage to enable said processor to access the telephone number of a second party to an ongoing telephone call, search said first database for a record containing said telephone number, and display a name, telephone number and other information associated with said record on the standalone portable device (see Figures 2 and 3).

Regarding claim 10, see Figures 2 and 3.

Regarding claim 11, see Figures 2 and 3.

Regarding claim 12, see Figures 2 and 3.

Regarding claim 14, see abstract.

Regarding claim 23, Stogel discloses a method comprising:

receiving in a first system a search query for information (paragraph 0011) associated with a second party during a telephone call, the first system comprising a portable device separate from a telephone (135, 133) and a personal-use computer (141, 145) and connectable to at least one of a telephone line (187) or the computer (141, 145);

obtaining the information from the first system if the information is present in the first system;

searching at least the personal-use computer (141, 145) for the information if the information is not present in the first system; and

providing the information to the first system from the personal-use computer and displaying the information on the first system (see Figures 2 and 3).

Regarding claim 25, see Figures 2 and 3.

Regarding claim 26, see Figures 2 and 3.

Regarding claim 27, see Figures 2 and 3.

Regarding claim 28, see Figures 2 and 3.

Regarding claim 39, see Figure 1.

Regarding claim 40, see paragraph 0037.

Regarding claim 41, see Figure 1.

Regarding claim 42, see Figure 1.

Regarding claim 43, see Figures 2 and 3.

Regarding claim 44, see Figure 1.

Regarding claim 45, see Figures 2 and 3.

Regarding claim 46, see Figures 2 and 3.

Regarding claim 47, see Figure 1.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 13, 29 and 30 are rejected under 35 U.S.C § 103(a) as being unpatentable over Stogel in view of Suzuki, U.S. Patent Application Publication No. 2001/0027098 (hereinafter Suzuki).

As per claim 13, Stogel does not explicitly disclose the storage stores a user preference table that indicates a preferred search hierarchy among a plurality of databases. Despite this shortcoming, Suzuki reveals this feature (see paragraph 0072). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Stogel with the hierarchy of Suzuki. This modification would have improved the convenience of Stogel by allowing a search process to be specified in advance a suggested by Suzuki.

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On the issue of claim 29, Stogel does not explicitly disclose enabling a user to define a search path for searching a plurality of remote sources for the information. Despite this shortcoming, Suzuki reveals this feature (see paragraph 0072). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Stogel with the hierarchy of Suzuki. This modification would have improved the convenience of Stogel by allowing a search process to be specified in advance as suggested by Suzuki.

As per claim 30, see Figure 1 of Stogel.

5. Claim 38 is rejected under 35 U.S.C § 103(a) as being unpatentable over Stogel in view of Sawaya, U.S. Patent No. 6,125,170 (hereinafter Sawaya).

Regarding claim 38, Stogel makes absolutely no mention of a printer housed in the portable device. Yet, Sawaya discloses this handy feature (see Figure 1). Thus, it would have been apparent to an individual of plain ability in the field to alter Stogel with the printer invented by Sawaya. This adaptation would have enhanced the user friendliness of Stogel by allowing visual indicia to be generated on a paper slip as suggested by Sawaya (see abstract).

Response to Arguments

6. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa

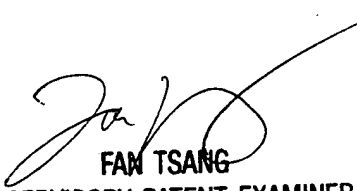
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Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

O.A.
Olisa Anwah
Patent Examiner
September 27, 2005


FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600